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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,308	06/26/2003	Ike W. Hornsby	13023-3	8928
7590	09/12/2005		EXAMINER	
James M. Duncan Klein, DeNatale, Goldner, Cooper, Rosenlieb & Kimball, LLP P.O. Box 11172 Bakersfield, CA 93389-1172			CECIL, TERRY K	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 09/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/608,308	HORNSBY, IKE W.
Examiner	Art Unit	
Mr. Terry K. Cecil	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 June 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) 1-6, 12 and 13 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 7 and 8 is/are rejected.

7)  Claim(s) 9-11 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 26 October 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a system (combination) for reducing swimming pool energy, classified in class 210, subclass 97.
  - II. Claims 7-11, drawn to a system (subcombination) for reducing swimming pool energy, classified in class 210, subclass 143.
  - III. Claims 12-13, drawn to a method for reducing swimming pool energy consumption, classified in class 210, subclass 776.
  
2. The inventions are distinct, each from the other because of the following reasons:
  - Inventions III and I and also III and II are related as process and apparatuses for its practice.  
The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatuses of Groups I and II can be used to practice another materially different process—e.g. one that does not require the suction cleaner for taking water and debris from the wall of the pool of Group III (Groups I and II only require a suction vacuum for receiving...which can be interpreted as a main drain at the bottom of a pool).  
  
• Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not

require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the valve/actuator of Group I does not require the first position wherein the input is from *both* sources of pool water of Group II. The subcombination of Group II has separate utility such as in a combination that does not require the bypass means of Group I.

- Restriction for examination purposes is proper because of the reasons given above and also because (i) they have acquired a separate status in the art as shown by their different classification, (ii) the search required for the respective groups is not necessarily required by each of the other groups, and (iii) their subject matter is recognized as divergent.

3. During a telephone conversation with James Duncan on 9-1-2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 7-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6 and 12-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC '103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meincke (U.S. 5,107,872) in view of Bajka (U.S. 4,322,297) and in further view of Frederick (U.S. 4,545,906). Meincke teaches an energy saving swimming pool cleaning and filtering system/method that comprises a dual-source inlet. As shown in figure 4b, the system includes

- a filter system circulatory path that includes an inlet from the pool, a pump 52, a filter 54, and an outlet to the pool;
- an embodiment including two sources for the inlet: a skimmer 40 and a suction vacuum (either cleaning device 60' or main drain 30 can be considered as a “suction vacuum for receiving...”);
- valving means (e.g. 48, 90, 92) that can be operated for receiving water from either, some, or all of the sources (col. 5, line 65 to col. 6, line 2);
- actuating means coupled to the valving means (that are located inline) for accomplishing said switching (controls 100) [as in claims 7-8].

Meincke is silent as to the type of pump. However, Frederick teaches a pump 18 that is a centrifugal pump having a motor and operating at two different speeds: 3450 rpm and 1750<sup>1</sup> rpm [as in claim 7]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the two-speed pump of Frederick in the invention of Meincke, since Frederick the benefits of energy cost savings and reduced noise pollution (col. 3, lines 55-58) by operating the pump at a lower speed when a higher speed is unnecessary<sup>2</sup>.

Meincke teaches a time clock controlling the actuating means 100 but does not mention a *programmable* input means. Bajka teaches a programmable timer in electrical communication with control valve actuators for controlling the pool cleaning operations (col. 3, lines 35-68) [as in claim 7]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention for the timer of Meincke, as modified by Frederick, to be programmable as in Bajka, since such would allow the preset timing arrangement of Meincke (col. 3, lines 55-58) to be modified as desired.

#### ***Allowable Subject Matter***

6. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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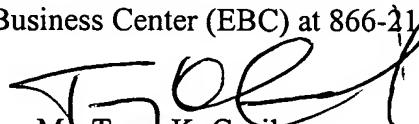
<sup>1</sup> The independent claims require a speed less than 3450 rpm.

<sup>2</sup> Although Frederick teaches a higher speed may be necessary when vacuuming, Meincke teaches that in his invention "no energy is required other than that normally required for circulation of water through the conventional filtration apparatus" (abstract). Therefore, Meincke could enjoy the aforementioned benefits even when in a cleaning mode.

7. The following is a statement of reasons for the indication of allowable subject matter:  
none of the closest cited art fails to anticipate or render obvious, alone or in any proper  
combination, the combination of elements making up the valve of claim 9.

8. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mr. Terry K. Cecil  
Primary Examiner  
Art Unit 1723

TKC  
September 1, 2005